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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,267	07/01/2002	Hans-Peter Kohlstadt	H 4186 PCT/US	9026

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HENKEL CORPORATION
THE TRIAD, SUITE 200
2200 RENAISSANCE BLVD.
GULPH MILLS, PA 19406

EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,267

Applicant(s)

KOHLSTADT ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/2/02, 2/15/02</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Applicants are required to amend the specification to include the appropriate section headings.

2. Applicants' originally filed application contained 18 claims. The preliminary amendment of January 2, 2002 canceled claims 1-12 and added new claims 13-27. The supplemental preliminary amendment of July 1, 2002, renumbered claims 13-27 as claims 19-33 and added new claims 34-38. Accordingly, the status of originally filed claims 13-18 remains unclear. The examiner has assumed that these claims are intended to be canceled; accordingly, they have not been further considered. Applicants are required to supply an amendment either canceling originally filed claims 13-18 or properly amending them for further consideration.

3. Foreign patent documents DE 3214056, EP 747408, EP 747409, and DE 2823762 cited within the Information Disclosure Statement, filed February 15, 2002, have not been considered, because applicants have failed to comply with the provisions of 37 CFR 1.98(a)(3).

4. Within lines 26-30 of page 4 of the specification, applicants have stated that the machine of the present invention is already known from the Düsphohl prospectus. Applicants are required to furnish this prospectus for consideration by the examiner. In view of applicants' statements, the examiner must determine if it constitutes prior art relevant to the subject matter of the instant claims.

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5. Claims 19-32 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claims 19, 32, and 38, it is unclear what is meant by “dosing”. It is unclear what steps the dosing operation encompasses.

Within claim 19, applicants have claimed a step of melting components A and B; therefore, it is unclear if components A and B are initially required to be solid.

Within claim 19, applicants have claimed “the steps of separately dosing and melting components A and B”; however, it is unclear if “separately” requires separate operations for dosing and melting, regardless of whether A and B are mixed, or if “separately” requires that components A and B be treated separately, regardless of whether dosing and melting occur in one step, or if “separately” requires that dosing and melting occur separately and that components A and B be treated separately.

Within claim 38, it is unclear what is meant by “an adhesives application”, as the language pertains to the claim.

6. Claims 19-25 and 28-38 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an apparatus and a process for the production of polyurethane hot-melt adhesives derived from an isocyanate reactant and a substance containing at least two functional groups reactive with isocyanate groups, does not reasonably provide enablement for an apparatus and a process for the production of polyurethane hot-melt adhesives derived from an isocyanate reactant and a component containing a group that is reactive with isocyanate groups. The specification does not enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Applicants have failed to teach how to make a polyurethane from exclusively monofunctional reactants; however, the reactive components of the claims require nothing more than monofunctionality. The position is taken that the claims should be commensurate in scope with the level of enablement disclosed by the specification.

Any inquiry concerning this communication should be directed to R. Sergeant at telephone number (571) 272-1079.


RABON SERGENT
PRIMARY EXAMINER

R. Sergeant

September 29, 2004